

R E M A R K S

Careful review and examination of the subject application are noted and appreciated.

TELEPHONE INTERVIEW SUMMARY

Applicant's representative, John Ignatowski, spoke with Examiner Poinvil on April 27, 2004 via telephone regarding the rejections of claims 1 and 21. The interview included a discussion regarding how a combination of Provost and Giannini could teach operating with two databases when each reference only discusses operating with a single database. No agreement was reached.

SUPPORT FOR THE CLAIM AMENDMENTS

Support for the claim amendments may be found in the specification, for example, on page 37 lines 23-24, page 41 line 14-16 and FIG. 2 as originally filed. Thus, no new matter has been added.

CLAIM REJECTIONS UNDER 35 U.S.C. §102

The rejection of claims 15, 16, 18-22, 24 and 25 under 35 U.S.C. §102(e) as being anticipated by Provost et al. '265 (hereafter Provost) has been obviated in part by appropriate amendment and is respectfully traversed in part and should be withdrawn.

Provost concerns a provider claim editing and settlement system (Title). In contrast, claim 21 provides (in part) steps for (i) receiving a bill comprising a particular billing code of a first plurality of billing codes each having a first budget amount stored in a first database and (ii) determining whether the particular billing code is present in a second database comprising a second plurality of billing codes. However, Provost appears to be silent regarding a system for handling accounts payable having two databases for billing codes. Provost also appears to be silent about searching the second database for a particular billing code received by the system. Therefore, Provost does not disclose or suggest steps for (i) receiving a bill comprising a particular billing code of a first plurality of billing codes each having a first budget amount stored in a first database and (ii) determining whether the particular billing code is present in a second database comprising a second plurality of billing codes as presently claimed.

Claim 21 further provides steps for generating an approval for payment of a billing amount. In contrast, Provost appears to be silent regarding an approval for payment. Instead, the text of Provost cited on page 2 of the Office Action discusses authorizing services covered by health care plans. Informing a health care provider that a requested procedure is covered by the patient's insurance is different than authorizing payment of a bill

resulting from the procedure. Therefore, Provost does not disclose or suggest steps for generating an approval for payment of a billing amount as presently claimed.

Claim 21 further provides that the approval is generated in response to the particular billing code matching none or one billing codes in the second database. In contrast, Provost appears to be silent regarding a second database of billing codes to compare against the particular billing code. Therefore, Provost does not disclose or suggest that approval is generated in response to a particular billing code matching none or one billing code in a second database as presently claimed. Claim 15 provides language similar to claim 21. As such, the claimed invention is fully patentable over the cited reference and the rejection should be withdrawn.

Claim 18 provides means for not approving payment in response to a corresponding one of a first budget amount and a second budget amount being less than a billing amount. In contrast, Provost appears to be silent regarding disapproving payment if a bill is too large. Furthermore, the text of Provost cited on page 3 of the Office Action appears to be silent regarding withholding payment approval. Instead, the cited text of Provost discusses informing a medical technician if a proposed medical procedure is covered by a patient's insurance plan. The cited text does not appear to discuss the costs of the procedures. Therefore,

Provost does not disclose or suggest means for not approving payment in response to a corresponding one of a first budget amount an a second budget amount being less than a billing amount as presently claimed. Claim 24 provides language similar to claim 18. As such, claims 18 and 24 are fully patentable over the cited reference and the rejection should be withdrawn.

CLAIM REJECTIONS UNDER 35 U.S.C. §103

The rejection of claims 1-4, 8-11 and 29 under 35 U.S.C. § 103(a) as being unpatentable over Provost and Giannini '241 (hereafter Giannini) has been obviated in part by appropriate amendment and is respectfully traversed in part and should be withdrawn.

The rejection of claims 17, 23, 26, 30 and 31 under 35 U.S.C. §103(a) as being unpatentable over Provost has been obviated in part by appropriate amendment and is respectfully traversed in part and should be withdrawn.

The rejection of claims 27 and 28 under 35 U.S.C. § 103(a) as being unpatentable over Provost, Giannini and Haggerson et al. '690 (hereafter Haggerson) is respectfully traversed and should be withdrawn.

Provost concerns a provider claim editing and settlement system (Title). Giannini concerns a method and system encoding and processing alternative healthcare provider billing (Title).

Haggerson concerns bundled billing accounting computer systems (Title).

Claim 1 provides (in part) a step for receiving into a system an approval for authorizing a particular billing code of a first plurality of billing codes each having a first budget amount stored in a first database. In contrast, Provost appears to be silent regarding receiving authorizations into a system. Furthermore, the text of Provost cited on page 5 of the Office Action does not discuss receiving authorizations into a system. Therefore, Provost and Giannini, alone or in combination, do not teach or suggest a step for receiving into a system an approval for authorizing a particular billing code of a first plurality of billing codes each having a first budget amount stored in a first database as presently claimed. The Examiner is respectfully requested to either (i) provide a clear and concise explanation how the cited text of Provost teaches or suggests the alleged authorization receiving operation or (ii) withdraw the rejection.

Claim 1 further provides steps for generating a communication authorizing either a first budget amount or a second budget amount associated with a particular billing code in response to the particular billing code matching none or one of a second plurality of billing codes. In contrast, each of Provost and Giannini appear to discuss operating from a single database. Neither Provost or Giannini appear to teach or suggest how to

authorize a budget amount using two databases. Therefore a combination of Provost and Giannini does not teach or suggest steps for generating a communication authorizing either a first budget amount or a second budget amount associated with a particular billing code in response to the particular billing code matching none or one of a second plurality of billing codes as presently claimed. The Examiner is respectfully requested to either (i) provide clear and particular cites and reasoning how Provost teaches generating a communication authorizing a budget amount between two databases or (ii) withdraw the rejection.

Furthermore, the Office Action fails to provide particular findings as to the reasons a skilled artisan, with no knowledge of the presently claimed invention, would have selected the cited references for combination. In particular, the assertion on page 5 of the Office Action that motivation exists to prevent insurance fraud or overpayment does not appear to be based on Provost, Giannini or knowledge generally available to one of ordinary skill in the art as required by MPEP §2142. The factual inquiry whether to combine references must be thorough and searching. The rigorous application of the requirement for showing the teaching or motivation to combine references is necessary to avoid the subtle but powerful attraction of a hindsight-based obviousness analysis. It is improper, in determining whether a person of ordinary skill in the art would have been led to the

combination of references, simply to use that which the inventor taught against its teacher. As such, because the Office Action fails to provide particular findings as to the reasons a skilled artisan, with no knowledge of the presently claimed invention, would have selected the cited references for combination, the Office Action does not appear to have met the Office's burden of factually establishing a *prima facie* case of obviousness (MPEP §2142). Claim 8 provides language similar to claim 1. As such, the claimed invention is fully patentable over the cited reference and the rejection should be withdrawn.

Claim 3 provides a step for generating an authorization form for a task before determining whether a particular billing code is present in a second database. In contrast, both Giannini and Provost appear to be silent regarding generation of an authorization form before checking in a second database. Therefore, Provost and Giannini, alone or in combination, do not teach or suggest a step for generating an authorization form for a task before determining whether a particular billing code is present in a second database as presently claimed.

Furthermore, the Office Action does not provided clear and particular evidence of motivation to modify the proposed reference combination. In particular, the asserted motivation on page 5 of the Office Action to "properly match codes in the two databases thereby detecting possible fraud" does not appear to

motivate the generation of authorization forms. The proposed modification generates the authorization form **before** checking in the second database yet matching codes can only be done **after** checking in the second database. In addition, motivation for detecting possible fraud does not explain why one of ordinary skill in the art would modify a generation of an authorization form. Therefore, *prima facie* obviousness has not been established. Claim 10 provides language similar to claim 3. As such, claims 3 and 10 are fully patentable over the cited references and the rejection should be withdrawn.

Claim 4 provides a step for receiving a selection of a firm associated with a second budget database prior to determining whether a particular billing code is present in the second database. In contrast, both Provost and Giannini appear to be silent regarding two databases where a second of the databases is associated with a firm. Each of Provost and Giannini also appear to be silent regarding receiving the firm selection before determining if a particular billing code is present in the (missing) second database. Therefore, Provost and Giannini, alone or in combination, do not teach or suggest a step for receiving a selection of a firm associated with a second budget database prior to determining whether a particular billing code is present in the second database as presently claimed. Furthermore, the assertion on page 5 of the Office Action regarding an insurance company

receiving billing codes for matching with their databases lacks any cites to either Provost and/or Giannini and thus is not evidence. Claim 11 provides language similar to claim 4. As such, the Examiner is respectfully requested to either (i) provide clear and particular evidence how Provost and/or Giannini allegedly teach the above claim limitation or (ii) withdrawn the rejection.

Claim 23 provides a step for checking a third database to determine whether a task has been completed before approving payment of a bill. The Office Action admits on page 4 that Provost does not explicitly teach checking for a task completion before approving payment, but instead asserts that "most entities or payors usually confirm that services or a specified task was rendered" before authorizing payment. However, the above assertion lacks evidence and thus is a conclusory statement. As such, the Examiner is respectfully requested to either (i) provide clear evidence that those of ordinary skill in the art of the present invention do check for task completion before authorizing payment or (ii) withdraw the rejection.

Claim 31 provides a step for approving payment of a corresponding one of a first budget amount and a second budget amount in response to a billing amount exceeding a corresponding one of a first budget amount and a second budget amount. In contrast, both Provost and Giannini appear to be silent regarding payment when a billing amount exceeds a budget amount. Therefore,

Provost and Giannini, alone or in combination, do not teach or suggest a step for approving payment of a corresponding one of a first budget amount and a second budget amount in response to a billing amount exceeding a corresponding one of a first budget amount and a second budget amount as presently claimed.

Furthermore, the Office Action does not provided clear and particular evidence of motivation to modify the proposed reference combination. In particular, the suggestion on page 4 of the Office Action to account for changes or errors in the authorized amount simply identifies potential problems. No evidence is provided why one of ordinary skill in the art would be motivated to implement the claimed step to solve the potential problems. The fact that references can be combined or modified is not sufficient to establish *prima facie* obviousness (MPEP §2143.01). Claim 30 provides language similar to claim 31. As such, the Examiner is respectfully requested to either (i) provide clear and particular evidence for motivation to make the proposed modification or (ii) withdraw the rejection.

Claim 27 provides a step for automatically sending an authorization form with a due date to a selected firm. In contrast, Provost, Giannini and Haggerson each appear to be silent regarding an authorization for with a due date. Furthermore, the text of Haggerson cited on page 5 of the Office Action appears to be silent regarding forms having due dates. Therefore, Provost,

Giannini and Haggerson, alone or in combination, do not teach or suggest a step for automatically sending an authorization form with a due date to a selected firm as presently claimed. As such, claim 27 is fully patentable over the cited references and the rejection should be withdrawn.

Claim 28 provides a step for entering one of a first budget amount and a second budget amount into a third database. In contrast, each of Giannini, Provost and Haggerson appear to be silent regarding entering data from two databases into a third database. Furthermore, the statement on page 6 of the Office Action that an "insurance company storing the budge amount in their database for potential conflict resolution purposes" lacks any references to Provost, Giannini and/or Haggerson and thus is not evidence. Therefore, Provost, Giannini and Haggerson, alone or in combination, do not teach or suggest a step for entering one of a first budget amount and a second budget amount into a third database as presently claimed. As such, claim 28 is fully patentable over the cited references and the rejection should be withdrawn.

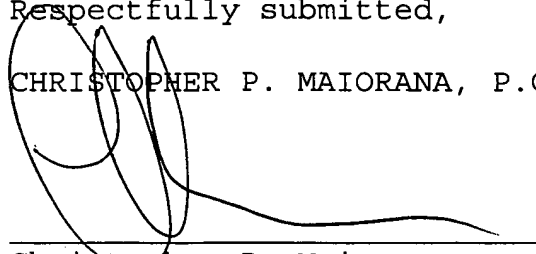
Accordingly, the present application is in condition for allowance. Early and favorable action by the Examiner is respectfully solicited.

The Examiner is respectfully invited to call the Applicant's representative at 586-498-0670 should it be deemed beneficial to further advance prosecution of the application.

If any additional fees are due, please charge Deposit Account No. 12-2252.

Respectfully submitted,

CHRISTOPHER P. MAIORANA, P.C.



Christopher P. Maiorana
Registration No. 42,829

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c/o Leo Peters
Intellectual Property Law Department
LSI Logic Corporation
1551 McCarthy Boulevard, M/S D-106
Milpitas, CA 95035

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